UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,612	12/02/2005	Michihiro Izumi	03500.018183.	1506

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FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER
MURRAY, DANIEL C

ART UNIT	PAPER NUMBER
2443	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/559,612	IZUMI, MICHIHIRO
	Examiner	Art Unit	
	DANIEL C. MURRAY	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 December 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>34-42</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>34-42</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

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DETAILED ACTION

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Claim Rejections - 35 USC § 101

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1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any
> new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of
> this title.

Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. **Claims 41 and 42** are rejected by virtue of their dependency on **claim**

40.

Claim 40 is rejected under 35 USC 101 since the claims are directed to non-statutory subject

matter. **Claim 40** recites a computer-readable storage medium which appears to cover both

transitory and non-transitory embodiments. The United States Patent and Trademark Office

(USPTO) is <u>required</u> to give claims their broadest reasonable interpretation consistent with the

specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989)

(during patent examination the pending claims must be interpreted as broadly as their terms

reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable

medium (also called machine readable medium and other such variations) typically covers forms of

non-transitory tangible media **and** transitory propagating signals *per se* in view of the ordinary and

customary meaning of computer readable media, <u>particularly when the specification is silent</u>. *See*

MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the

claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re*

Nuijten, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to

statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The Examiner suggests that the Applicant add the limitation "non-transitory computer-readable storage medium" to the claim(s) in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification. The examiner also suggests that the specification be amended to include the term "non-transitory computer-readable storage medium" to avoid a potential objection to the specification for a lack of antecedent basis of the claimed terminology.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

4.   **Claims 34-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chimura et al. (US Patent # US 6,400,719 B1)** in view of **Strauss et al. (US Patent # 5,940,598)** in view of

Mussman et al. (US Patent Publication # US 2004/0139209 A1) in further view of **Nada (US 2002/0095516 A1).**

a) Consider **claims 34, 37, and 40,** Chimura et al. clearly show and disclose, a communication apparatus, control method, and computer-usable medium comprising: a central processing unit (figure 2, column 4 lines 55-67); a memory unit coupled to the central processing unit (figure 2, column 4 lines 55-67); a Voice over Internet Protocol (VoIP) connection unit adapted to establish a VoIP channel using a VoIP protocol through an Internet Protocol (IP) network (figure 1, figure 7, abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 15-34, column 5 lines 45-67, column 6 lines 1-3); an IP communication unit adapted to communicate image data to a communication partner station using a predetermined file transmission protocol through the IP network (figure 1, figure 7, abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 15-34, column 5 lines 45-67, column 6 lines 1-3); an IP address obtaining unit adapted to obtain an IP address of the communication partner station from a proxy server, based on a telephone number of the communication partner station (figure 1, figure 7, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34). However, Chimura et al. does not specifically disclose a facsimile communication unit adapted to perform facsimile communication using a facsimile protocol; obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol); a determination unit adapted to determine whether a data communication through the IP network uses the predetermined file transmission protocol; and a control unit adapted to select the facsimile communication unit or the IP communication unit, in accordance with a determination by the determination unit, wherein, if the determination unit determines that the data communication through the IP network uses the predetermined file transmission protocol, the control unit selects the IP communication unit and, if the determination unit determines that the

data communication through the IP network does not use the predetermined file transmission protocol the control unit selects the facsimile communication and wherein, if the control unit selects the IP communication unit, the control unit causes the IP communication unit to communicate the image data to the communication partner station using the predetermined file reception transmission protocol using the IP address of the communication partner station obtained by the obtaining unit, and, if the control unit selects the facsimile communication unit the control unit causes the facsimile communication unit to communicate the image data to the communication partner using the facsimile protocol communication via the VoIP communication channel established by the VoIP connection unit using the IP address of the communication partner station obtained by the obtaining unit.

Strauss et al. show and disclose a universal or multipurpose network server having enhanced processing functions which are performed in association with a telecommunications network to provide multi-mode communications via a combination of the public switched telephone network (PSTN) and a public packet data network, such as the Internet, wherein Strauss et al. discloses a facsimile communication unit adapted to perform facsimile communication using a facsimile protocol (figure 4, abstract, column 1 lines 57-61, column 7 lines 23-29 lines 40-53, column 8 lines 10-20).

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Strauss et al. and Chimura et al. since both concern multimode/telephone communication systems communicating over public switch telephone network (PSTN) and public packet data network (IP network) and as such, both are with in the same environment.

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate a facsimile communication unit adapted to perform facsimile communication using a facsimile protocol, as taught by, Strauss et al. into the system of Chimura et al. for the purpose of transmitting a facsimile signal (Strauss; column 7 lines 23-29), thereby allowing the transmission of facsimile data. However, Chimura et al. as modified by Strauss et al. does not specifically disclose obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol); a determination unit adapted to determine whether a data communication through the IP network uses the predetermined file transmission protocol; and a control unit adapted to select the facsimile communication unit or the IP communication unit, in accordance with a determination by the determination unit, wherein, if the determination unit determines that the data communication through the IP network uses the predetermined file transmission protocol, the control unit selects the IP communication unit and, if the determination unit determines that the data communication through the IP network does not use the predetermined file transmission protocol the control unit selects the facsimile communication and wherein, if the control unit selects the IP communication unit, the control unit causes the IP communication unit to communicate the image data to the communication partner station using the predetermined file reception transmission protocol using the IP address of the communication partner station obtained by the obtaining unit, and, if the control unit selects the facsimile communication unit the control unit causes the facsimile communication unit to communicate the image data to the communication partner using the facsimile protocol communication via the VoIP communication channel established by the VoIP connection unit using the IP address of the communication partner station obtained by the obtaining unit.

Mussman et al. show and disclose an apparatus which includes a device configured to support a first protocol for initiation, maintenance, and termination of a communication session between call endpoints, and to support a second protocol for resolving endpoint addresses for the communication session wherein, Mussman et al. discloses obtaining an IP address of the communication partner station is accomplished by using SIP (Session Initiation Protocol)(abstract, paragraph [0003], [0013], [0014]).

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Mussman et al. and Chimura et al. as modified by Strauss et al. since both concern routing of communication (i.e. audio, video, data, etc.) over a network and as such, both are with in the same environment.

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate using SIP (Session Initiation Protocol), as taught by, Mussman et al. into the system of Chimura et al. as modified by Strauss et al. for the purpose of initiation, maintenance, and termination of a communication session (Mussman; abstract), thereby allowing communication session to be established. However, Chimura et al. as modified by Strauss et al. as modified by Mussman et al. does not specifically disclose a determination unit adapted to determine whether a data communication through the IP network uses the predetermined file transmission protocol; and a control unit adapted to select the facsimile communication unit or the IP communication unit, in accordance with a determination by the determination unit, wherein, if the determination unit determines that the data communication through the IP network uses the predetermined file transmission protocol, the control unit selects the IP communication unit and, if the determination unit determines that the data communication through the IP network does not use the predetermined file transmission protocol the control unit selects the facsimile

communication and wherein, if the control unit selects the IP communication unit, the control unit

causes the IP communication unit to communicate the image data to the communication partner

station using the predetermined file reception transmission protocol using the IP address of the

communication partner station obtained by the obtaining unit, and, if the control unit selects the

facsimile communication unit the control unit causes the facsimile communication unit to

communicate the image data to the communication partner using the facsimile protocol

communication via the VoIP communication channel established by the VoIP connection unit using

the IP address of the communication partner station obtained by the obtaining unit.

   Nada shows and discloses an Internet telephone system and an Internet telephone apparatus

using the Internet wherein an IP address obtaining means judges by analyzing the telephone number

of the communication partner whether or not the communication with the communication partner

station through a VoIP transmission path is possible, wherein Nada discloses a determination unit

adapted to determine whether a data communication through the IP network uses the

predetermined file transmission protocol (abstract, [0028], [0039], [0047], [0052], [0058], [0064]); and

a control unit adapted to select the facsimile communication unit or the IP communication unit, in

accordance with a determination by the determination unit (abstract, paragraph [0028], [0052],

[0058], [0064]), wherein, if the determination unit determines that the data communication through

the IP network uses the predetermined file transmission protocol, the control unit selects the IP

communication unit (abstract, paragraph [0028], [0052], [0058], [0064]) and, if the determination unit

determines that the data communication through the IP network does not use the predetermined file

transmission protocol the control unit selects the facsimile communication (abstract, paragraph

[0028], [0052], [0058], [0064]) and wherein, if the control unit selects the IP communication unit, the

control unit causes the IP communication unit to communicate the image data to the

communication partner station using the predetermined file reception transmission protocol using

the IP address of the communication partner station obtained by the obtaining unit (abstract,

paragraph [0028], [0052], [0058], [0064]), and, if the control unit selects the facsimile communication

unit the control unit causes the facsimile communication unit to communicate the image data to the

communication partner using the facsimile protocol communication via the VoIP communication

channel established by the VoIP connection unit using the IP address of the communication partner

station obtained by the obtaining unit(abstract, paragraph [0028], [0052], [0058], [0064]).

One of ordinary skill in the art at the time the invention was made would have been

motivated to combine the teachings of Nada and Chimura et al. as modified by Strauss et al. as

modified by Mussman et al. since both concern communication systems communicating over public

switch telephone network (PSTN) and public packet data network (IP network) and as such, both

are with in the same environment.

Therefore, it would have been obvious to one of ordinary skill in the art that the time the

invention was made to incorporate communicating using determining whether or not the

communication through a VoIP transmission path is possible, as taught by, Nada into the system of

Chimura et al. as modified by Strauss et al. as modified by Mussman et al. for the purpose of analog

facsimile communication when communication on the IP network based on the predetermined file

reception protocol cannot be performed (Nada; paragraph [0064]), thereby allowing the facsimile

communication to be complete regardless of the type of network.

b) Consider **claims 35, 38, and 41,** and **as applied to claims 34, 37, and 40 above,**

Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada

clearly show and disclose, the communication apparatus, control method, and computer-usable

medium according to claim 34, 37, and 40, wherein the determination unit judges whether the data

communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, if the data communication cannot be performed with the communication partner station via the VoIP communication channel, the control unit calls the communication partner station on the line switching network and causes the facsimile communication unit to perform analog facsimile communication (Nada; abstract; paragraph [0028], [0052], [0058], [0064]).

c) Consider **claims 36, 39, and 42,** and **as applied to claims 34, 37, and 40 above,** Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada clearly show and disclose, the communication apparatus, control method, and computer-usable medium according to claim 34, 37, and 40, wherein the determination unit judges whether a communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, if the communication can be performed with the communication partner station via the VoIP communication channel, the IP address obtaining unit tries to obtain the IP address of the communication partner station from the SIP proxy server (Chimura; abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34, Mussman; (discloses using SIP to set up communications) paragraph [0003], [0013], [0014]).

Response to Arguments

5.   Applicant's arguments filed 14 DEC2009 have been fully considered but they are not

persuasive.

Applicant argues that a combination of Chimura et al., Mussman et al., Strauss et al., and

Nada, would fail to teach or suggest a "determination unit adapted to determine whether a data

communication through the IP network uses the predetermined file transmission protocol."

The Examiner respectfully disagrees; Nada clearly discloses determination unit adapted to

determine whether a data communication through the IP network uses the predetermined file

transmission protocol (abstract, [0028], [0039], [0047], [0052], [0058], [0064]). Nada clearly discloses

determination unit (server/controller) adapted to determine whether a data communication

(telephone call) through the IP network uses the predetermined file transmission protocol (Internet

Protocol). Nada clearly discloses a telephone number of the destination side telephone set 11 is

entered in the calling side telephone set 2. The modem 1 accesses the server 7 to check if the IP

address corresponding to the telephone number is present or not. At this time, if there is no IP

address corresponding to the telephone number of the partner in the server 7, the following

operation is executed. The controller 13 shown in FIG. 2 judges that the partner does not have an

Internet telephone, and changes over the transmission line switch 19 from the audio processor 17

side to the PSN interface 14 side. Thus, a call is made to the partner through the PSN. Nada clearly

discloses a controller (determination unit) determining whether communication through the IP

network is possible by determining if the destination telephone is able to communicate using

Inherent Protocol (predetermined file transmission protocol). Therefore, Nada clearly discloses

determination unit adapted to determine whether a data communication through the IP network

uses the predetermined file transmission protocol.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

> ➢ US 7,620,682 B1
> ➢ US 2010/0042737 A1
> ➢ 5,712,712
> ➢ US 6,230,189 B1
> ➢ US 2002/0002609 A1

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to DANIEL C. MURRAY whose telephone number is 571-270-1773. The

examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Tonia Dollinger can be reached on (571)-272-4170. The fax phone number for the organization

where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. C. M./
Examiner, Art Unit 2443

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443